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In re Application of :
Sibley et al. :
Serial No.: 09/829,631 : PETITION DECISION
Filed: April 10, 2001 :
Attorney Docket No.: NIH047.1 CP1C1 :

Applicants' filed on 3/25/04 a request for review by the Group Director. This is deemed to be a petition filed under 37 CFR 1.181.

BACKGROUND

Applicants' request review of the issue as to whether the instant application is a continuation-in-part or continuation of the parent application.

DISCUSSION

Applicants' request review of the issue whether "by containing the desired set of claims rather than adding the desired set of claims by preliminary amendment, the continuation does not contain new matter and cannot be redesignated as a continuation-in-part". Applicants' statement is true, but only if the desired set of claims do not contain new matter, in regard to the specification as originally filed.

Applicants' assert that MPEP 201.06(c) indicates that the Patent Office strongly recommends that a continuation application contain only the desired set of claims rather than add the desired set of claims by preliminary amendment.

With respect to applicants arguments MPEP 201.06(c) states "When a copy of the oath or declaration from a prior application was filed in a continuation or divisional application, if the examiner determines that new matter is present relative to the prior application, the examiner should notify the applicant in the next Office Action (preferably the first Office Action). The examiner should require: (A) a new oath or declaration along with the surcharge set forth in 37 CFR 1.16(e), and (B) that the application should be redesignated as a continuation-in-part".

A review of the history shows that the examiner in the office action mailed 7/10/02 determined the claims as originally filed contained new matter, and required applicants provide a

supplemental oath and redesignate the application as a continuation-in part. The Office action mailed 7/10/02 further sets forth on the record that originally filed claims 1-16 of the instant application are not the same as those originally filed in the parent application 08/428,242 and the claims would have been considered to constitute new matter.

Accordingly, given the record provides reasons to why the original claims of the instant application would constitute new matter, applicants provide no reasons in the petition to why claims 1-16 originally filed in the instant application do not contain new matter the designation of the application as continuation in part of the parent application is proper.

Applicants further argue the MPEP indicates that the prior set of claims was properly indicated by reference by a statement in the application transmittal letter specifically referring to the prior application and therefore status as a continuation application is proper. However, a review of the file history shows that it is the application as filed, not as later amended, which determines its status as a continuation or continuation-in-part. In this case the claims as originally filed contained new matter and mandated designation as continuation-in-part. See MPEP 206.01 (c) which sets forth that "a continuation or divisional application filed with a newly executed oath or declaration contains subject matter that would have been new matter in the prior application, the application will have to be amended to indicate that it is a continuation-in-part application rather than a continuation or divisional application". What determines the status of the later filed application as a continuation or continuation-in-part is whether the disclosure (i.e., the specification and claims) of the application is the same as the parent application. The mere fact that the later filed application contains the desired set of claims is not determinative of whether the later filed application is a continuation rather than a continuation-in-part.

DECISION

For the reasons set forth above the designation of the application as a continuation-in-part is affirmed and Applicants' petition is **DENIED**.

Should there be any questions with respect to this decision, please contact Anthony C. Caputa by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0829 or by facsimile transmission at 703-872-9306.



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